

Remarks

Claims 1-8 are presently pending. Claims 1-8 have been amended. Claim 9-16 have been cancelled.

The Examiner has found the previously submitted "Amendment C" to be non-compliant for the following reasons: the claims were not contained on a separate sheet in accordance with MPEP article 608.01(m); there are remarks and claims on the same page of applicants response (page 5); single brackets were used to delete matter; matter was deleted or added without using underlining or strike-through or double brackets.

The amendment has been corrected to address these shortcomings and is now in full compliance with article 714 II. C of the MPEP. Specifically, underlining, double brackets and strike through has been used where appropriate to indicate additions or deletions from the claims and the claims and remarks appear on separate pages.

The Applicant requests that the Examiner take into consideration the following Remarks related to the rejection of Claim 1 previously submitted in "Amendment C",

submitted on October 12, 2005, and in support of the Request for Continued Examination.

The Examiner rejected Claims 1, 4-6, and 8 under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu. The Examiner states that Miyasu (Figs. 1,4, Abstract [0015]) discloses an alignment means extending upwardly from an exterior surface from a shaft end to a cap end, an alignment means being an elongated ridge in alignment with a longitudinal axis of a body and an external surface being circular. The Examiner went on to say that Miyasu does not disclose the external surface being circular throughout the length of the shaft but clearly an artisan designing a grip with a uniform feel would have selected a suitable shape throughout the length in which circular is included. In view of the patents of Miyasu it would have been obvious to modify the grip of 2001-46568 to have an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end and an alignment means being an elongated ridge in alignment with a longitudinal axis of a body in order to assist a golfer in properly aligning a club at impact. In view of the patents of Miyasu, it would have been obvious to modify the grip of 2001-46568 to have a grip having an

external surface substantially circular cross-sectional configuration throughout the length of a shaft by having the shape stay the same.

This rejection is respectfully but strenuously traversed for the reasons set forth in detail below.

In general, three basic criteria must be satisfied in order to establish a prima facie case of obviousness (M.P.E.P. § 706.02(j)). First, the reference or combination of references must teach or suggest all of the claim limitations. Second, there must be a reasonable expectation of success. Third, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Applicant has amended Claim 1 to make it easier to read and understand and also to claim an integrally formed alignment means for positioning the grip body in the hands of a user extending upwardly from the exterior surface of said grip body in alignment with the longitudinal axis of said golf club shaft and adapted in cooperation with the

increasing diameter of said grip body from said cap end to said shaft end of said grip body whereby said grip adjacent to said shaft end of said grip body provides an improved grip for the user's hand and better control of the golf club. (The additional structure is supported in the specification on page 8, lines 11-15 and page 13, lines 6-10). Applicant respectfully submits that these clarifications further distinguish the present invention from the prior art and as such, overcome the Examiner's rejection of Claim 1.

Furthermore, Applicant stated in Amendment B that the failure of the cited references to (a) specifically describe or infer the critical limitations required by the original and amended claims, or (b) disclose or direct the modification between Applicant's invention and that disclosed in the cited reference, precludes the establishment of the necessary prima facie case of obviousness. Accordingly, Applicant continues to believe that Examiner's rejection of Claim 1 has been overcome.

The 2001-46568 patent issued in 2001 some two years prior to the filing date of Miyasu (02/21/2003). Miyasu was obviously aware of prior art residing in the Japanese

patent system (Miyasu specifically cited several examples of Japanese prior art in paragraphs [0004] and [0005]) but apparently ignored or overlooked 2001-46568. Miyasu (Figs. 1 and 2, paragraph 0004 and 0017) consistently refers to conventional or regular grips but makes no mention of the reverse-taper grip. Applicant respectfully submits that Miyasu, arguably one skilled in the art, did not see the combination of the elongated rib and the reverse-taper grip as obvious because the inventive feature of Miyasu was introduced "to provide a grip ... which prevents hands from slipping away ... and which comforts the hands while the grip is held by the hands." (paragraph [0007]). Applicant combined the reverse-taper grip and the elongated rib to stabilize the swing and increase the moment of inertia and thereby eliminate the user's tendency to slice the ball. In view of these assertions of non-obviousness, Applicant respectfully submits that the Examiner's rejection of Claim 1 has been overcome.

The Applicant requests that the Examiner take into consideration the following Remarks related to the rejection of Claims 2 and 3 previously submitted in "Amendment C", submitted on October 12, 2005, and in support of the Request for Continued Examination.

The Examiner rejected Claims 2-3 and 7 under 35 U.S.C § 103(a) as being unpatentable over 2001-46568 in view of Miyasu as applied to Claims 1, 4-6, and 8 and further in view of Hadge. In response to the Examiner's comments in paragraphs 4 and 6, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 2, 3 and 7 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1. Applicant respectfully submits that Hadge, like 2001-46568 and Miyasu, fails to:

- (1) provide a basis for modifying the grip disclosed by the present invention;
- (2) suggest that such a modification would be successful;
- (3) disclose some beneficial effect inherent in such a modification; and
- (4) render obvious the present invention as a whole.

Applicant therefore respectfully submits that the Examiner's rejections of Claims 2, 3 and 7 have been overcome.

The Applicant requests that the Examiner take into consideration the following Remarks related to the

rejection of Claims 4, 5 and 6 previously submitted in "Amendment C", submitted on October 12, 2005, and in support of the Request for Continued Examination.

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claims 4, 5 and 6 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

The Applicant requests that the Examiner take into consideration the following Remarks related to the rejection of Claim 7 previously submitted in "Amendment C", submitted on October 12, 2005, and in support of the Request for Continued Examination.

In response to the Examiner's comments in paragraphs 4 and 6, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 7 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claims 2 and 3.

The Applicant requests that the Examiner take into consideration the following Remarks related to the

rejection of Claim 8 previously submitted in "Amendment C", submitted on October 12, 2005, and in support of the Request for Continued Examination.

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 8 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

Applicant has attached three declarations to this Amendment that attest to the commercial success of the present invention. Applicant maintains that the field in which the present invention resides (golf equipment) is so competitive and lucrative that improvements are implemented as soon as they are recognized. The present invention has enjoyed substantial commercial success since it was first introduced because consumers (both recreational and professional golfers) recognize and realize the innovative step of combining the reverse-taper grip and the elongated reminder rib.

The first declaration addresses the sales figures realized by Applicant since introducing the present

invention as well as supporting comments received from the four major golf retailers in the United States. Applicant has provided a financial summary to substantiate the assertion of commercial success. The second declaration addresses comments provided by satisfied customers who have used the present invention and can attest to its innovative qualities. Applicant has provided copies of E-mail correspondence to substantiate the assertion of commercial success. The third declaration addresses independent testing of the present invention by an American testing facility and a Japanese testing facility. Please consider all documentation previously submitted.

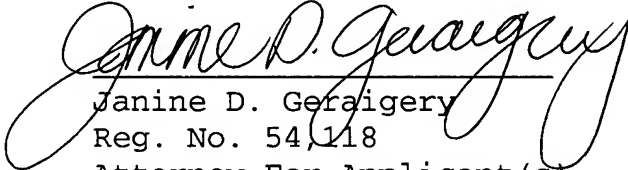
Because of the enormous world-wide market for golf equipment (tens of millions of recreational golfers worldwide) and the lucrative rewards attendant to the introduction of innovative products, there exists within the industry an intense competition to design, develop, and introduce innovative products that will capture a portion of that enormous world-wide market. Applicant respectfully submits that:

- (1) in view of the market for new, innovative golf equipment, and
- (2) in view of the financial rewards involved,

if combining the two inventive features was obvious as the Examiner suggests, someone would have done so before the Applicant.

In view of the foregoing remarks, reconsideration and allowance of the pending claims are respectfully solicited. The Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in cursive script, reading "Janine D. Geraigery", written over a horizontal line.

Janine D. Geraigery
Reg. No. 54,118
Attorney For Applicant(s)
Law Offices of JD Geraigery, PC
56 Creighton Street
Cambridge, MA 02140
(617) 491-2201

JDG/